



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,199	12/07/2001	Motonori Nakamura	50212-317	8188

20277 7590 09/14/2004

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AC

Office Action Summary**Application No.**

10/005,199

Applicant(s)

NAKAMURA ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Newly amended claims 1-5 are now directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1-5 as originally presented, searched and examined required a

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-5 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As indicated in the previous Office action, the claims are confusing because one cannot tell what is meant by the marking point being “toward” the dummy rod – see previous Office action.

Claims 2-3 each refer to “either dummy rods” (sic) – it is unclear if such is suppose to be interpreted as: either dummy rod, both dummy rods or something else.

Furthermore, there is no antecedent basis for any dummy rod being “beyond said marking point”. The same applies to claim 7.

Claim 2: there is no antecedent basis for “said glass synthesizing burners” line 4.

Claim 5: last line: there is no antecedent basis for “said marking points.”

Examiner could only find mention of a single marking point. It is unclear whether the claim is suppose to claim only one or both of the disclosed marking points. The same applies to claims 1, 6 and 9

The term “marking points” is indefinite as to its meaning (claims 1-9). The specification (page 3, last full sentence) identifies what is meant by the term of two different ‘cases’. However, there is no indication as to what is meant by the term for other cases – such as the case of claim 1 – which is not either of the cases of page 3. There is no “case of stopping...” nor a “case using auxiliary burners”. Furthermore, it is unclear whether there must actually be any marks/markings. The term “marking” is misleading if there is no actual mark.

Claim 9: it is unclear if the semi colon of line 9 is a typographical error, and if not, how it effects the claim interpretation. Line 15 the significance of only one bracket and one parenthesis is not understood.

Claim 1, line 11 there is no (or improper) antecedent basis for “the dummy rod” – see previous Office action for a better explanation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikura JP 3-126633.

Claim 1: Fujikura, figure 1 shows the invention. IT is unclear how the dummy rods are attached: it would have been obvious to fuse the rods – because using an adhesive might contaminate the preform – or it might melt during the process. The spraying and depositing is also shown – however the burner is moved rather than the rod. It would have been obvious to have the preform rod move rather than the burner, because all that is required is relative movement and it doesn't matter which one is doing the moving.

As to the limitation that “each marking point is set” – Fujikura has no marking points. Therefore it correct to say that each of Fujikura's marking points are set as claimed. Or to put it another way: Claims are given their broadest reasonable interpretation. It is deemed that the broadest reasonable interpretation of the last 9 lines of claim 1 is: “if there are marking points, then each marking point is set at a position...” Since the “if” requirement is not met in Fujikura, the “then each...” result is not required. The claims do not require there be any marking point – thus it is improper for the Office to interpret the claims as requiring something that is not mentioned. It is

also noted that the TITLE of the application does not mention any marking points – so it is deemed that such is not a pivotal part of the invention.

Claim 2: The Fujikura reciprocating occurs whenever the marking point is reached (which is never). Fujikura also has other reversing points – the claim is open to having other reversals. Claims 3-4 and 6-8 are similarly met.

Response to Arguments

Regarding the marking points – the arguments refer to Exhibit B. Examiner could not find anything in file wrapper that corresponds to Exhibit B. However, it does not seem important, because it is what the claims require. It does not matter if the intention is to limit the claims to Exhibit B – what matters is what the claims explicitly call for. Examiner is not able to reasonably figure all of Applicant's intentions. Likewise, Examiner cannot find any Exhibit A. Examiner understands the disclosed invention – thus it does not appear the Exhibit is very important. In the discussion of the Exhibits, it appears such are only directed to the disclosed invention – and not the claim. There does not appear to be any attempt to correlate the Exhibits with the language found in the claims. Moreover, the arguments just attempt to point out the claims are definite – without even addressing the particular points/rationale made in the rejection. Applicants arguments should clearly point out the specific errors in the rejection – if it is deemed

there are errors. Present arguments appear only to address the Office's conclusion while ignoring the basis for the Office's conclusion.

The argument regarding antecedent basis for "soot body formed" is convincing.

The arguments regarding the "marking points" are noted, but are not convincing because they do not address the rationale in the rejection. In other words – the exhibits (probably) show an embodiment of the marking points. However, examiner is sure that Applicants do not wish the claims be limited to that specific embodiment. The claims have to be definite so that the public can determine what is and what is not covered by the claims.

Conclusion

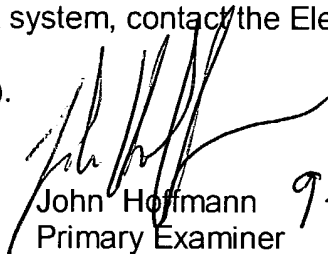
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

9-13-04

jmh